

PTO/SB/33 (07-05)

United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 59643.00232
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/657,700
	Filed: September 9, 2003
	First Named Inventor: Jarko NIEMENMAA
	Art Unit: 2617 Examiner: Charles T. Shedrick

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

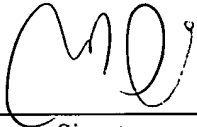
The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed
- ☒ Attorney or agent of record.
Registration No. 54,749

- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


SignatureMajid S. AlBassam

Typed or printed name

703-720-7898

Telephone number

June 23, 2006

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _____ forms are submitted.



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jarko NIEMENMAA

Art Unit: 2617

Application No.: 10/657,700

Examiner: Charles T. Shedrick

Filed: September 9, 2003

Attorney Dkt. No.: 59643.00232

For: LOCATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 23, 2006

Sir:

Applicants respectfully request a review of the final rejections set forth in the final Office Action dated January 31, 2006, and as further maintained in the Advisory Action of May 9, 2006, finally rejecting claims 1-23. Applicants respectfully submit that a prima facie case for obviousness has not been established with respect to claims 1-23. Further, Applicants submit that there is clear error with regard to at least one element of claims 1, 9, 13, and 14, upon which claims 2-8, 10-12, and 15-23 are dependent.

Claims 1-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zadeh (U.S. Patent No. 6,047,182) in view of Fischer (U.S. Patent No. 6,295,455). The Office Action took the position that Zadeh discloses all of the elements of the claims,

with the exception of “handing over the user equipment for communicating on a second channel with a second different serving base station, wherein said determination of the location of the user equipment is suspended until said handing over from the first serving base station to the second different base station has been completed.” The Office Action then cites Fischer as allegedly curing this deficiency in Zadeh.

Applicants respectfully submit that the present claims recite subject matter which is neither disclosed nor suggested by the combination of Fischer and Zadeh, and that, therefore, the final rejections are improper and without basis. Zadeh and Fischer do not disclose or suggest that the “determination of the location of the user equipment is suspended until said handing over from the first serving base station to the second different base station has been completed,” as recited in claims 1, 13, and 14, and similarly recited in claim 9. The Office Action, as discussed above, acknowledges that Zadeh fails to teach this feature of the claims. However, the Office Action asserts that Fischer allegedly discloses these features. Applicants respectfully submit that this assertion is in error as Fischer also fails to disclose these features of the claims.

Fischer teaches that the transmission of position measuring data should not effect the transmission of more important signaling data, and, therefore, makes it possible to delay the transmission of the position measuring data in order to make way for critical signaling data (Fischer, Column 10, lines 5-11, and Fig. 3). Consequently, the manner in which data bursts are stolen in order to transmit position measuring data on a channel must take into account the type of data being transmitted in the data bursts. However,

Fischer is concerned with a method relating to the insertion of position measuring data into a channel, and for the call connection between the mobile station and a base transceiver station (Fischer, Fig. 3). Therefore, Fischer does not disclose or suggest that the method should be implemented during handoff from a first serving base station to the second different serving base station, as recited in the present claims.

Fischer further discloses a method of controlling the transmission of positioning data during handoff. Fischer specifically discloses that “position measuring data can be transmitted during or following a handover operation” (Fischer, Column 14, lines 54-56). The operation of the system during handoff is determined by setting a flag to instruct both the mobile station and the location measurement units to perform one of: (1) continue transmitting positioning data over a previously used channel after handoff to a new channel, (2) stop all transmission of positioning data, or (3) postpone handoff to the new channel until the positioning data has been transmitted (Fischer, Column 14, line 62 – Column 15, line 5).

Applicants respectfully submit that none of the options disclosed by Fischer correspond to suspending the determination of the location of the mobile station during the handover operation, as recited in the present claims. Rather, the first and third options of Fischer, as outlined above, teach the continuation of the positioning operation through the handoff procedure. The second option disclosed by Fischer teaches that the mobile station should stop the transmission of positioning data and perform the handover as ordered. Fischer does not disclose or suggest if or how the transmission of positioning

data might continue once the handover has been successfully completed. As such, Applicants respectfully submit that stopping the transmission of positioning data as disclosed by Fischer does not correspond to suspending the determination of the location of the user equipment, as recited by the present claims.

According to embodiments of the present invention, while the determination of the mobile station position is suspended, it is not necessary for the mobile station to stop the transmission of positioning data nor is it necessary to provide any command or indicator to the mobile station to begin transmission once handover is completed. In contrast, Fischer teaches the continuation of the transmission of positioning data through the handoff procedure or, alternatively, that the transmission of positioning data should stop completely thereby allowing a new positioning operation to be started once handoff has been completed. Accordingly, Fischer fails to disclose or suggest that the determination of the location of the mobile station should be suspended during the handoff procedure as recited in the present claims. Zadeh, as acknowledged in the Office Action, also fails to disclose or suggest this limitation of the claims.

Therefore, Applicants respectfully assert that the combination of Fischer and Zadeh fails to disclose or suggest all of the elements of claims 1, 9, 13, and 14. As such, Applicants submit that the rejection is improper and without basis.

Applicants note that claims 2-8, 10-12, and 15-23 are dependent upon claims 1, 9, and 14, respectively. Therefore, claims 2-8, 10-12, and 15-23 should be allowed for at

least their dependence upon claims 1, 9, and 14, and for the specific limitations recited therein.

For at least the reasons discussed above, Applicants respectfully assert that there is clear error in that the Office Action has failed to establish a prima facie case for obviousness, as the cited combination of Fischer and Zadeh does not disclose or suggest all of the elements of the presently pending claims. It is therefore respectfully requested that all of claims 1-23 be allowed, and this application passed to issue.

In the event there are any fees due with respect to the filing of this paper, please charge Counsel's Deposit Account 50-2222.

Respectfully submitted,



Majid S. AlBassam
Registration No. 54,749

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

MSA:jf

Enclosures: Pre-Appeal Brief Request for Review PTO/SB/33
Notice of Appeal
Petition for Extension of Time
Check No. 14633